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Mailed: June 2, 2003

Hearing:
April 10, 2003

Paper No. 12
BAC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re East Penn Manufacturing Company, Inc.

Serial No. 76/166,175

Zachary T. Wobensmith, III, Esq. for East Penn
Manufacturing Company, Inc.

Robert Clark, Trademark Examining Attorney, Law Office 108
(David Shallant, Managing Attorney).

Before Simms, Seeherman and Chapman, Administrative
Trademark Judges.

Opinion by Chapman, Administrative Trademark Judge:

On November 16, 2000, East Penn Manufacturing Company, Inc. (a Pennsylvania corporation) filed an application to register the mark MARINE MASTER on the Principal Register for "electric storage batteries" in International Class 9. The application is based on applicant's claimed date of first use and first use in commerce of February 1997. In response to a requirement and an inquiry of the Examining

Attorney, applicant disclaimed the word "marine," and claimed ownership of Registration No. 2,419,712, issued January 9, 2001, for the mark GOLF MASTER ("golf" disclaimed) for "electric storage batteries."

Registration has been refused under Section 2(d) of the Trademark Act, 15 U.S.C. §1052(d), on the ground that applicant's mark, when applied to its identified goods, so resembles the registered mark MARINEMASTER for "steering controls and assemblies for marine use"¹; and for "push-pull controls, throttle controls, shift controls, and parts thereof for marine use,"² both registered to the same entity, (American Chain & Cable Company, Inc., a New York corporation, which subsequently changed its name to FKI Industries, Inc.), as to be likely to cause confusion, mistake or deception.

When the refusal was made final, applicant appealed. Briefs have been filed. An oral hearing was held before the Board on April 10, 2003.

We affirm the refusal to register. In reaching this conclusion, we have followed the guidance of the Court in *In re E. I. du Pont de Nemours & Co.*, 476 F.2d 1357, 177

¹ Registration No. 1,028,593, issued December 30, 1975, Section 8 affidavit accepted, renewed.

² Registration No. 1,064,327, issued April 26, 1977, Section 8 affidavit accepted, renewed.

USPQ 563 (CCPA 1973). See also, *In re Majestic Distilling Company, Inc.*, 315 F.3d 1311, 65 USPQ2d 1201 (Fed. Cir. 2003). In any likelihood of confusion analysis, two key considerations are the similarities between the marks and the similarities between the goods and/or services. See *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24 (CCPA 1976). See also, *In re Dixie Restaurants Inc.*, 105 F.3d 1405, 41 USPQ2d 1531 (Fed. Cir. 1997); and *In re Azteca Restaurant Enterprises Inc.*, 50 USPQ2d 1209 (TTAB 1999).

The involved marks are virtually identical, differing only by the space between the words MARINE MASTER in applicant's mark. Applicant acknowledges that "[t]here is no dispute as to the identity of the marks." (Brief, p. 3, and reply brief, p. 1.) This fact "weighs heavily against applicant." *In re Martin's Famous Pastry Shoppe, Inc.*, 748 F.2d 1565, 223 USPQ 1289, 1290 (Fed. Cir. 1984). Indeed, the fact that an applicant has selected the identical mark of a registrant "weighs [so] heavily against the applicant that applicant's proposed use of the mark on "goods... [which] are not competitive or intrinsically related [to registrant's goods]...can [still] lead to the assumption that there is a common source." *In re Shell Oil Co.*, 992 F.2d 1204, 26 USPQ2d 1687, 1688-1689 (Fed. Cir. 1993).

"The greater the similarity in the marks, the lesser the similarity required in the goods or services of the parties to support a finding of likelihood of confusion." 3 J. McCarthy, McCarthy on Trademarks and Unfair Competition, §23:20.1 (4th ed. 2001).

We turn to a consideration of the cited registrant's goods (in both registrations) and applicant's goods. Applicant contends that its "electric storage batteries" and the cited registration's "steering controls and assemblies for marine use" and "push-pull controls, throttle controls, shift controls, and parts thereof for marine use" are very different goods; that applicant's goods and the goods identified in the cited registrations are not related and would not be manufactured in the same facilities; that the manufacture of applicant's "electric storage batteries" is very specialized, involving "a very limited number of manufacturers," and also requiring "highly specialized equipment," whereas the manufacture of registrant's goods "does not require specialized equipment" (brief, p. 4); that applicant and registrant are not competitors and any "expected expansion of registrant's product line of mechanical controls and assemblies for marine use would not be electric storage batteries" (brief, p. 5); that the Examining Attorney's evidence does not

establish the involved goods are related; that the involved goods of applicant and registrant are purchased "only after careful thought and consideration" (brief, p. 5); that these goods are sold to "a small and sophisticated group" who purchase the goods "for repair, or replacement of existing items" (reply brief, p. 2); that the goods are sold "in a very limited number of outlets which cater to a very limited clientele" who are "highly discriminating and uniquely familiar with the providers of such goods" (brief, p. 6); and that "both Applicant's and Registrant's goods are sold personally" and involve investigation and inspection prior to purchase, thereby dispelling any confusion (brief, p. 6).

As evidence thereof, applicant submitted advertising literature concerning its product, applicant's news releases regarding its MARINE MASTER batteries, and a "Marine Master Ad Schedule."

The Examining Attorney argues that the parties' goods are related and/or complementary in that they are all boating accessories used in the operation, maintenance and repair of boats; that these goods travel in the same channels of trade; that there is no restriction in applicant's identification of goods as to trade channels and there is evidence of the same trade channels; that

prospective purchasers (boat owners) would likely assume that batteries, steering controls for marine use and push-pull controls, throttle controls and shift controls for marine use, when sold under the same mark, emanate from a single source; that even if the purchasers are sophisticated this does not mean that they are sophisticated about trademark law, or that they are immune from source confusion; and that doubt on the issue of likelihood of confusion must be resolved against applicant as the newcomer.

In support of his position, the Examining Attorney submitted (i) several third-party registrations, each of which issued on the basis of use in commerce, and (ii) printouts from some Internet web sites.

It is well settled that goods need not be identical or even competitive in order to support a finding of likelihood of confusion. Rather, it is sufficient that the goods are related in some manner or that the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons in situations that would give rise, because of the marks used thereon, to a mistaken belief that they originate from or are in some way associated with the same producer or that there is an association between the producers of the goods or services.

See In re Martin's Famous Pastry Shoppe, Inc., supra; In re Opus One Inc., 60 USPQ2d 1812 (TTAB 2001); and In re Peebles Inc., 23 USPQ2d 1795 (TTAB 1992).

The Internet web site pages provided by the Examining Attorney include (i) Boat Accessories and Supplies Catalog which lists categories of equipment such as "engine parts and accessories" and "steering and engine controls"; (ii) Marine Equipment & Supplies which lists categories of equipment such as "batteries & accessories," "engines & parts" and "steering systems, wheels & controls"; and (iii) Tri-Lakes Center which lists categories of equipment such as "engine accessories and systems" and "batteries."

When considering the third-party registrations submitted by the Examining Attorney, it is settled that third-party registrations are not evidence of commercial use of the marks shown therein, or that the public is familiar with them. Nonetheless, third-party registrations which individually cover a number of different items and which are based on use in commerce have some probative value to the extent they suggest that the listed goods emanate from a single source. See In re Albert Trostel & Sons Co., 29 USPQ2d 1783, 1785 (TTAB 1993); and In re Mucky Duck Mustard Co., Inc., 6 USPQ2d 1467, footnote 6 (TTAB 1988).

We recognize, as argued by applicant, that the third-party registrations do not include specific listings of the exact same products involved herein (i.e., "electric storage batteries" in the current application, and "steering controls and assemblies for marine use" and "push-pull controls, throttle controls, shift controls, and parts thereof for marine use" in the cited registrations). However, the third-party registrations made of record by the Examining Attorney include the following: Registration No. 1,846,483 issued for, inter alia, "electric starter switches, ... marine battery terminals, ...push-pull switches," and "... engine throttle controls"; Registration Nos. 1,807,020 and 1,807,021, both issued for, inter alia, "electronic controls for navigational aides and signaling equipment, ... batteries, ... electrical power supplies, and ... electronic regulators for use in navigational equipment"; and Registration No. 1,006,011 issued for, inter alia, "motor boat accessories, namely, ... power steering units," "motor boat electrical components, namely, engine ignition systems, ... and electrical power isolators," "throttle control mechanisms," and "motor boat instruments, namely, ... battery meters." These registrations indicate that goods of the same general type as the applicant's and registrant's may emanate from a

single source, and the third-party registrations and web site materials further indicate that there is a commercial relationship between electric storage batteries and marine steering controls, throttle controls and shift controls.

We find that the Examining Attorney has established that applicant's goods and the goods in each of the two cited registrations are related. See *Hewlett-Packard Company v. Packard Press, Inc.*, 281 F.3d 1261, 62 USPQ2d 1001, 1004 (Fed. Cir. 2002) ("even if the goods and services in question are not identical, the consuming public may perceive them as related enough to cause confusion about the source or origin of the goods and services").

Applicant argues that there is a separate and specialized manufacturing process required to produce electric storage batteries vis-a-vis the manufacturing of various steering and throttle controls for boats. However, the argument is not relevant to our determination of the registrability of applicant's mark. As the Court of Appeals for the Federal Circuit stated in the case of *In re Majestic Distilling Company, Inc.*, supra at 1204:

Although the PTO apparently found no evidence of any manufacturer who both brews malt liquor and distills tequila, Majestic has not shown that the PTO's lack of evidence in that regard is relevant. Unless consumers are aware of the fact, if it is one, that no brewer

also manufactures distilled spirits, that fact is not dispositive. The *DuPont* factors require us to consider only "trade channels," which may be, but are by no means necessarily, synonymous with manufacturing channels. In this case, Majestic has not demonstrated that consumers distinguish alcoholic beverages by manufacturer rather than brand name.

Likewise, in the case now before the Board, there is no evidence that consumers distinguish the involved goods by manufacturer or manufacturing process, rather than by brand name.

The record before us establishes that the respective goods of the parties are related in a commercially significant manner, and thus are associated or related goods in the minds of the consuming public. See *Seaguard Corporation v. Seaward International, Inc.*, 223 USPQ 48 (TTAB 1984) (SEA GUARD for a resilient cushion for placement between a marine vessel and a structure or between two sea vessels held confusingly similar to SEA GUARD and design for marine paint); *In re Cruising World, Inc.*, 219 USPQ 757 (TTAB 1983) (CRUISING WORLD for outlet services for yachts and marine accessories held confusingly similar to CRUISING WORLD for a magazine); and *Gulf Oil Corporation v. Gulf Marine Products Corp.*, 158 USPQ 613 (TTAB 1968) (GULF for pleasure boats held confusingly similar to GULF for gasoline, diesel fuel and lubricating

oils and greases, all designed and intended for use in boats, and batteries and battery accessories which are adaptable for use in boats).

We note that registrant's goods are limited to "...for marine use." However, applicant has included no restriction as to trade channels or purchasers or uses of its "electric storage batteries" in its identification of goods. Thus, its goods, as identified, are broad, including all types of electric storage batteries, (including those for marine use) and must be deemed to be offered to all classes of customers through all normal channels of trade. In point of fact, applicant's specimens of record as well as its advertising literature make clear that applicant's batteries are primarily for marine use and, additionally, applicant sells batteries for use in recreational vehicles. Thus, the Board must consider that the parties' respective goods could be offered and sold to the same class of purchasers (boat owners interested in marine accessories and engine parts) through all normal channels of trade. See *Octocom Systems Inc. v. Houston Computers Services Inc.*, 918 F.2d 937, 16 USPQ2d 1783 (Fed. Cir. 1990); *Canadian Imperial Bank of Commerce, National Association v. Wells Fargo Bank*, 811 F.2d 1490, 1 USPQ2d

1813 (Fed. Cir. 1987); and In re Smith and Mehaffey, 31 USPQ2d 1531 (TTAB 1994).

Applicant also argues that the purchasers of these goods are sophisticated, and purchase the goods for very specific uses after investigation and inspection. While we agree that the purchase of electric storage batteries and various steering and throttle controls for marine use would be made with some degree of care, nonetheless, we find that, even assuming that the purchasers of the goods in question are discriminating purchasers, this does not mean that such purchasers are immune from confusion as to the origin of the respective goods, especially when sold under the identical mark. See Weiss Associates Inc. v. HRL Associates Inc., 902 F.2d 1546, 14 USPQ2d 1840 (Fed. Cir. 1990); Aries Systems Corp. v. World Book Inc., 23 USPQ2d 1742, footnote 17 (TTAB 1992); In re Pellerin Milnor Corporation, 221 USPQ 558 (TTAB 1984); and Aerojet-General Corporation v. American Standard, Inc., 171 USPQ 439 (TTAB 1971). Simply put, even a purchaser who exercises a great deal of care would not recognize that MARINE MASTER and MARINEMASTER represent two different sources of the goods.

According to applicant, there have been no instances of actual confusion in about five years of coexistence of applicant's mark and the mark in the two cited

registrations. However, there is no evidence of applicant's and registrant's geographic areas of sales; nor is there information as to the amount of registrant's sales. Further, there is no information from the registrant as to its experience of any confusion. In any event, the test is likelihood of confusion, not actual confusion. See *Weiss Associates Inc. v. HRL Associates Inc.*, supra; and *In re Kangaroos U.S.A.*, 223 USPQ 1025 (TTAB 1984).

Finally, any doubt on the question of likelihood of confusion must be resolved against the newcomer as the newcomer has the opportunity to avoid confusion, and is obligated to do so. See *TBC Corp. v. Holsa Inc.*, 126 F.3d 1470, 44 USPQ2d 1315 (Fed. Cir. 1997); and *In re Hyper Shoppes (Ohio) Inc.*, 837 F.2d 840, 6 USPQ2d 1025 (Fed. Cir. 1988).

Based on the identity of the marks, the relatedness of the parties' respective goods, and the similarity of the trade channels and purchasers, we find that there is a likelihood that the purchasing public would be confused when applicant uses MARINE MASTER as a mark for electric storage batteries.

Decision: The refusal to register under Section 2(d) of the Trademark Act is affirmed as to both cited registrations.